

**REMARKS/ARGUMENTS**

In view of the amendments and remarks herein, favorable reconsideration and allowance of this application are respectfully requested. By this Amendment, claims 40, 44, 56, and 82 are amended, claim 48 is cancelled, and claims 88-90 are added. Thus, claims 40, 42-47, 49-59, and 82-90 are pending for further examination. A Request for Continued Examination (RCE) is being filed herewith.

**Preliminary Matters**

The firm responsible for prosecuting this patent application has changed. To this end, an Exclusive Substitute Power of Attorney (including the required certification) and a Correspondence Address Indication Form are being filed herewith. As indicated on these forms, correspondence in connection with this case should now be directed to Nixon & Vanderhye, P.C., Customer No. 23117.

An Applicant-Initiated Interview Request Form also is being filed herewith.

**Rejections under 35 U.S.C. § 103(a)**

Claims 40, 43, 46, 48-51, 54-59, 82-84, and 87 stand rejected under 35 U.S.C. § 103(a) as allegedly being made “obvious” over Brosnan et al. (U.S. Patent No. 6,656,040) in view of Astaneha (U.S. Patent No. 6,302,395) and further in view of Ungaro et al. (U.S. Publication No. 2003/0036426). This rejection is respectfully traversed for at least the following reasons.

From the outset, Applicant notes that gaming players have desired games that are more exciting and stimulating. For example, gaming players have increasingly wanted to be able to have additional betting opportunities provided to them during a game. Many players desire to have several bets or games going at the same time so that if one game fails to win then they may win another game. Unfortunately, a difficulty of adding additional betting opportunities to a

table game is that such additional betting opportunities must be provided in a manner that does not confuse the game player and that does not unduly slow down the underlying game. Although some approaches involve combining the elements from multiple games into a single game playable on a table, and although different approaches involve coming up with new games that involve complicated side bets, it remained difficult to bridge the longstanding gap between gaming machines (e.g., slot machines) and table games (e.g., poker, blackjack, and other table games) so as to provide two completely separate games thereon.

Certain exemplary embodiments of Applicant's claimed invention address this desire, as well as the difficulties associated with improving table games. Indeed, certain exemplary embodiments of Applicant's claimed invention provide first and second games of chance playable on a single gaming device/system, with at least the first game of chance being a live game of chance playable on a table with a live dealer, and with a second game of chance being playable by a player, while at the table, via a second game play area thereon. A player may wager on either or both of the first and second games of chance from the single gaming device. Furthermore, as claim 40 makes clear, for example, the first game outcome and the second game outcome are independent of each other, and the first and second game outcomes are not combined to provide an outcome separate from the first and second same outcomes.

Turning now to the rejection on the merits, Applicant respectfully submits that the alleged three-way combination of Brosnan, Astaneha, and Ungaro fails to teach or suggest each and every limitation of at least the independent claims. For example, Brosnan, Astaneha, and Ungardo, alone and in combination, fail to teach or suggest "a table having a horizontal top surface configured to enable a player to play a live first game of chance having a first game outcome . . . [along with] a second game play area configured to enable the player to play, while

at the table,” as required by claim 40 (and its dependents), or the similar limitations of claims 56 and 82 (and their respective dependents). Additionally, Applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have combined such disparate references in the manner alleged in the Final Office Action. Thus, the alleged Brosnan/Astaneha/Ungaro combination fails to render obvious claims 40, 56, and 82 (and their respective dependents).

Brosnan is clearly and unambiguously directed to gaming machines, and not to table games. For example, Brosnan notes at col. 1, lines 7-10 that its “invention relates to methods of allowing game players to play multiple games in parallel on a video gaming machine.” Brosnan’s specification reiterates the same throughout each of the embodiments disclosed therein. The figures of Brosnan show gaming machines and not table games, and even the claims of Brosnan are directed to gaming machines or parallel games on gaming machines, or methods relating to the same. Although Brosnan’s “catch-all” paragraph at col. 17, lines 22-30 states that gaming machines can be vertically or horizontally oriented, it is still quite clear that Brosnan is limited solely to gaming machines -- and there is no teaching or suggestion whatsoever regarding table games. Thus, contrary to the assertion made on page 3 of the Final Office Action, Brosnan clearly does not teach “an area on the horizontal top surface of the playing table for playing cards. . . .”

In Brosnan, there is no live action, at all. Nor is there “a table having a horizontal top surface configured to enable a player to play a live first game of chance having a first game outcome . . . [along with] a second game play area configured to enable the player to play, while at the table,” as clearly required by claim 40 (or the similar features recited in claims 56 and 82). As explained below, Astaneha is similarly deficient in this regard.

In searching for a reason to combine Brosnan and Astaneha, page 5 of the Office Action states that “It has been well known throughout the art that casino games may be played at gaming tables with dealers.” Applicant agrees. Casino games like poker and blackjack have been played at tables with dealers for decades. However, Applicant cannot agree with the statement that “Astaneha clearly shows that more than one type of game can be played at a gaming table at one time.” What Astaneha “clearly shows” is that the elements of multiple games can be combined to come up with new games. Each “new game” then may be played at one of Astaneha’s specialized tables. Indeed, Astaneha discloses “borrowing” elements from card games, wheel games, and dice games (for example, see col. 6, lines 56-63), and then playing one of three new games on a suitably configured apparatus (see “First Game,” “Second Game,” and “Third Game” at cols. 8-9). However, col. 9, lines 24-32 make clear that “gambling game 10 [in the singular] includes a combination of different gambling elements. . .” (emphasis added).

Astaneha therefore merely stands for the proposition that one type of game that can be played at a gaming table can incorporate a combination of different gambling elements (i.e., cards, a wheel, and dice for Astaneha). This is fundamentally different from allowing more than one type of game to be played at a gaming table at one time. Indeed, it is fundamentally different from “a table having a horizontal top surface configured to enable a player to play a live first game of chance having a first game outcome . . . [along with] a second game play area configured to enable the player to play, while at the table,” as clearly required by claim 40 (and the similar features recited in claims 56 and 82).

In its search for a motivation for making such a combination, page 5 of the Final Office also argues that, “Players also enjoy the personal contact with a live dealer versus an electronic machine.” While this statement may be true, it actually argues against combining Brosnan and

Astaneha. Indeed, Brosnan as shown above is clearly directed to gaming machines that represent an individualized approach to gaming, whereas Astaneha is interested in the type of camaraderie (see, for example, col. 9 of Astaneha) to which the Final Office Action appears to be alluding. Some people prefer to be left alone to gamble at their own pace without the boisterousness of large crowds, whereas other people prefer the excitement of being associated with a group. Indeed, the difference between table games and gaming machines now observed by the Final Office Action supports Applicant's position reiterated above -- namely, there is a fundamental difference between table games and gaming machines, and there have been difficulties tying the two together. In any event, considering the individualistic nature of the gaming machines of Brosnan and the group action based environment that Astaneha strives for, one of ordinary skill in the art at the time of the invention would not have combined the references in the manner alleged in the Final Office Action, for at least those reasons actually provided therein.

Differently stated, Brosnan and Astaneha actually teach away from one another, thus arguing against their combination.

Yet, even if one were to forcibly combine the teachings of Brosnan and Astaneha (which Applicant believes would not have been done, anyway), one of ordinary skill in the art at the time of the invention would have been led to something quite different from that which is claimed. More particularly, one of ordinary skill in the art at the time of the invention combining Brosnan and Astaneha would have made an electronic version of Astaneha's game. In other words, Astaneha's game would be implemented on a gaming machine rather than on a live, specialized table. Page 6 of the Final Office Action seems to support this view, as it discussed a so-called "video game format resulting from the 103 combination [of Astaneha] with Brosnan." But implementing Astaneha's game on a gaming machine -- with or without Brosnan's teachings

that other games on the gaming machine could be played in parallel -- still is not the same as the claimed invention. Indeed, it is a far cry from "a table having a horizontal top surface configured to enable a player to play a live first game of chance having a first game outcome . . . [along with] a second game play area configured to enable the player to play, while at the table," as clearly required by claim 40, and the similar features recited in claims 56 and 82. As this argument in the Final Office Action and the argument provided at the bottom of page 6 apparently gloss over, Applicant's claimed invention is not at all concerned with a gaming machine implementation. Instead, it is concerned with a table having a live dealer for playing first game and having a different second game also being playable while at the table.

In view of the above-noted fundamental deficiencies of the alleged three-way combination of Brosnan, Astaneha, and Ungaro, reconsideration and withdrawal of this Section 103 rejection are respectfully requested.

There are additional reasons why the alleged three-way combination of Brosnan, Astaneha, and Ungaro fails to render obvious claims 40, 56, and 82 (and their respective dependents). Some of these additional reasons are set forth below.

First, the Final Office Action at page 6 admits that Brosnan and Astaneha, alone and in combination, fail to explicitly disclose "a vertically disposed game outcome display connected to the top surface adjacent the dealer position, the game outcome display being adapted to display the second game outcome," as claimed in claim 40, or the similar features of claim 56 and 82. The Final Office Action nonetheless somehow argues that such features are inherent in the combination of Brosnan and Astaneha. Applicant respectfully submits that this is improper as a matter of patent law. "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

*In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981). See also *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (BPAI 1986) (“[T]he examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art” before the burden is shifted to the applicant to disprove the inherency.). Furthermore, the Board of Patent Appeals and Interferences recently issued the precedential opinion *Ex Parte Whalen II*, Appeal No. 2007-4423, decided on July 23, 2008, which, in addition to reiterating the above, found that “The Examiner has not provided evidence or scientific reasoning to show that any specific composition disclosed by Evans is within the scope of the instant claims, and therefore has not made out a case of inherent anticipation by Evans.”

In this case, as shown above, the alleged combination of Brosnan and Astaneha would not have a live dealer at all, since the resultant forced combination of the two would involve parallel games implemented on a gaming machine. Even if the alleged combination of Brosnan and Astaneha did have a live dealer, Astaneha does not state or even hint at where a dealer might stand and Brosnan has no human dealers at all. In fact, it is possible that a live dealer could stand anywhere around the specialized table, although it is more probable that a live dealer would move around, as there is a lot of action taking place at Brosnan’s table. Yet, as noted above, inherency law is not concerned with possibilities or probabilities -- rather, it is concerned with what must follow. The claimed arrangement in claim 40 of a “a vertically disposed game outcome display connected to the top surface adjacent the dealer position, the game outcome display being adapted to display the second game outcome” (or the similar arrangements claimed in claims 56 and 82) need not necessarily follow from Brosnan, Astaneha, Ugardo, or the alleged

combination thereof. Thus, the above-noted features of claims 40, 56, and 82 cannot be inherent in either reference, much less the alleged combination thereof.

In the related discussion of the motivation for the combination, page 7 of the Final Office Action states that locating a display on a table “is merely physical structure that does not directly related [sic] to how the games of Astaneha (‘395) or Ungaro (‘326) are actually played.” This is incorrect, as the claims clearly recite that at least the outcomes are displayed and thus the claimed display directly relates to how the games are played. Indeed, Applicant does not believe that it is unreasonable to say that outcomes are necessary for the playing of games.

Moreover, simply recognizing the “advantages and effects” of placing a display in a particular position is not the same as making something obvious. Indeed, because the Final Office Action fails to establish first and second games of chance being playable on or at a single table, recognizing such “advantages and effects” not only is improper, but also is indicative of improper hindsight analysis. Moreover, it may have been true at the time of the invention that vertical displays might have been “applied” to roulette games as argued on page 7 of the Final Office Actions, as such “applications” might have been known in the context of simply showing a wheel on a display screen. However, the Final Office Action does not show that a roulette game is played in connection with a separate live card game operating underneath the roulette game. Thus, it is improper to “apply” such displays to arrangements such as those claimed in claims 40, 56, and 82.

Second, there seems to be some confusion regarding “negative limitations” and the following discussion on pages 9-10 of the Final Office Action. For example, even if the features in question were negative limitations, these features should still carry patentable weight and should be treated as such.

In this discussion on pages 9-10, the Final Office Action indicates that Astaneha discloses combined bets. This is not so. As shown above, all that Astaneha discloses is a bet in connection with a single game that includes elements of multiple conventional games (i.e., cards, a wheel, and dice). As also shown above, Astaneha simply does not teach or suggest a game that has separate game outcomes for first and second games of chance. This is because Astaneha merely discloses a single game of chance.

Similar arguments apply with respect to the allegation that Brosnan and Astaneha are “analogous art in that the [sic] both disclose parallel games of different types being played on the same surface.” But Astaneha does not disclose parallel games at all. Instead, Astaneha discloses a new combination game that is played on a table that incorporates elements of different types of conventional games. Brosnan does disclose parallel games, but its parallel games are played on a gaming machine’s video display. A gaming machine’s video display cannot reasonably be considered “a common surface” at all, much less a common surface of a table game.

In addition, the statement that “A game outcome based on the result of two otherwise independent games is merely a bonus or a jackpot outcome meant to entice players to play” is both incorrect and inapposite. First, those skilled in the art at the time of the invention would understand the terms “bonus” and “jackpot” to mean quite different things from the definition advanced in the Final Office Action. Second, Applicant’s claimed invention is not concerned with a game outcome based on the result of two otherwise independent games. Rather, Applicant’s claimed invention is concerned with first and second separate outcomes that may occur when first and second games of chance are played.

Finally, page 10 for the first time cites to Caro (U.S. Patent No. 5,636,838) as allegedly providing the motivation for making some sort of combination. However, the reason or way in

which Caro is introduced is never made explicit, either in the Response to Arguments section or in the Detailed Action section of the Final Office Action. If Caro does indeed disclose two roulette wheels, such is completely unlike the claimed invention, which plainly requires a dealer of a first game and a separate second game. In any event, if the Examiner intends to rely on Caro, any rejection based thereon should be made explicit in the next Office Action.

For at least these additional reasons, Applicant respectfully submits that the alleged three-way combination of Brosnan, Astaneha, and Ungaro fails to render obvious claims 40, 56, and 82 (and their respective dependents).

In addition, the introduction of Huard et al. (U.S. Patent No. 5,743,800), Adams (U.S. Patent No. 5,911,418), and/or Pohanka (U.S. Patent No. D273,310) fails to make up for the above-noted fundamental deficiencies with the alleged Brosnan/Astaneha/Ungaro combination.

New claims 88-90 have been added to claim originally disclosed subject matter. New claims 88-90 should be allowable at least by virtue of their dependence from one of the allowable independent claims, in addition to their further distinguishing technical features.

In view of the foregoing amendments and remarks, withdrawal of the rejections and allowance of this application are earnestly solicited. Should the Examiner have any questions regarding this application, or deem that any formalities need to be addressed prior to allowance, the Examiner is invited to call the undersigned attorney at the phone number below.

BRADLEY JOHNSON  
Appl. No. 10/825,490  
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Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:



Chris Comuntzis  
Reg. No. 31,097

CC/JR:lmj  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100